REMARKS

Applicant has amended the specification and claims in order to more particularly define the invention taking into consideration the outstanding Official Action. Applicant has amended the specification at page 6 to correct the word "Bakelite" to "BAKELITE" to reflect that this is a well known trade mark and have added the generic description of phenolic resins. The claims have been also been corrected in this regard. The claims have been appropriately amended. This amendment does not introduce new matter into the specification. The dependencies of claims 26-29 have been amended as suggested by the Examiner. The Examiner's helpful suggestion is very much appreciated. Accordingly, it is most respectfully requested that the objections to the specification and claims be withdrawn.

That is, claims 26-29 have been amended to correct the dependency from claim 24 to claim 25 as suggested by the Examiner. Claims 17, 20, 21 and 24 have been amended to correct the informalities and misspellings as noted on page 2 of the Official Action. Accordingly, it is most respectfully requested that this objection be withdrawn.

Applicant most respectfully submits that all the claims now present in the application are in full compliance with 35 U.S.C. §112 and are clearly patentable over the references of record.

The rejection of the claims under 35 U.S.C. §103(a) as being obvious over Shen et al. in view of Pollmann et al. has been carefully considered but is most respectfully traversed.

Applicant wishes to direct the Examiner's attention to the basic requirements of a prima facie case of obviousness as set forth in the MPEP § 2143. This section states that to establish a prima facie case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The bioactive film in the specification is made by a solution comprising a bioactive agent which is dropped on the carrier of the plate electrode and dried at 40-60˚C, with the purpose of protecting the bioactive agent (include enzyme) from losing its activity during the drying process. It further changes the plate electrode from hydrophobic to hydrophilic.

The Shen reference clearly and unequivocally discloses a <u>non-enzymatic</u> plate electrode that detects uric acid. The reaction film of plate electrode is made by the carrier and conductive mediator being screen printed o the plate electrode and drying at 40-80˚C (col. 11, lines 16-19). The drying temperature is higher than that of the presently application. The conductive mediator comprises an electrolyte with a lower redox potential than that of uric acid. The reaction film does not contain an enzyme. One advantage of the Shen reference invention, as stated at column 6, lines 51-53, is to eliminate the use of any bio-active substances such as enzymes. This is a clear and unequivocal teaching away from the presently claimed invention as would be appreciated by one of ordinary skill in the art to which the invention pertains. The only such teaching is in Applicant's specification which may not be used as a teaching reference. In re Fritch, 23 USPQ 1780, 1784(Fed Cir. 1992) ("It is impermissible to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.).

It is further urged in the Official Action that Shen does not specifically teach the use of an adhesive on the periphery of the circular area, it is the Examiner's position that since Shen's protection film is coated on and around the circle and that it inherently

adheres to the substrate as a coating, that the protection film acts as an adhesive to adhere itself to the substrate. This statement is specifically traversed and does not suggest the claim limitation requiring disposing an adhesive layer at the periphery of the circular area. This claim limitation cannot be ignored and is not inherent in the prior art.

Thus, one of ordinary skill in the art would be directed away from using the Pollmann which discloses an enzymatic plate electrode. Since the reference citations belong to two different application fields, it is not easy to combine these arts. Again, it is clear that Applicant's specification is providing the motivation and not the prior art. Such reliance on hindsight is impermissible as noted above, Moreover, the requirement of the claim for a dripping step is not a claim limitation which cannot be ignored. The Examiner's position of this point is specifically traversed. A small stream could be used and this would not be considered to involve drop-wise addition. Accordingly, it is most respectfully requested that this rejection be withdrawn.

In view of the above comments and further amendments to the specification and claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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REF:kdd
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December 16, 2003